



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/697,554	10/26/2000	Akihiro Yamada	SONY-U0362	4006
22850	7590	09/07/2004	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			COBURN, CORBETT B	
			ART UNIT	PAPER NUMBER
			3714	
DATE MAILED: 09/07/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/697,554

Applicant(s)

YAMADA, AKIHIRO

Examiner

Corbett B. Coburn

Art Unit

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 August 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 101***

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 1-8 & 14-32 are rejected under 35 U.S.C. 101 because the disclosed invention is inoperative and therefore lacks utility. Applicant has added the limitation, "said game executing device being configured as a game controller without storage means for storing game software". No game executing device (computer) is operable without some sort of storage means (memory) for storing software. Applicant has claimed a computer without RAM, ROM, disk drives, processor registers, etc. No computer could possibly function without at least some of these storage means. In short, Applicant's device could not function to execute games in the embodiment now claimed.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-8 and 14-32 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The game executing device being configured without storage means for

Art Unit: 3714

storing game software appears to be new matter. Applicant must either cancel the limitation or show where it is supported in the original specification.

5. Claims 1-8 & 14-32 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Applicant has added the limitation, a game executing device being configured as a game controller without storage means for storing game software. This is not and cannot be enabled. A computerized device that executes a game must load the game program into RAM. This RAM is a storage means for storing game software. Applicant cannot be contemplating a dumb terminal or a direct connection of a joystick (or similar input device) to the system because these would not be game **executing** devices.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-8 & 14-32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant has added the limitation, “being configured as a game controller without storage means for storing game software”. The term “storage means” is undefined. Thus storage means can include any means of storing data – from punched tape to flash memory. Since the term is not defined, the scope of the claim cannot be determined. As pointed out above, the game executing device must have some sort of storage means in order to function. Thus Examiner must determine which storage means are intended by the claim

Art Unit: 3714

language – which storage means to keep and which to disallow. Since there is no guidance, the claim is indefinite. Examiner will treat the claim as requiring that there be no flash memory.

8. Claims 1-32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant has included the limitation “having drive means”. “Drive means” is undefined. It could be a floppy disk drive, a tape drive, a drum drive, a hard disk drive, a cd-rom drive, a cdrw-drive, a DVD-drive, etc. Since the term is not defined, the claims are indefinite. Examiner will assume that drive means includes any mass storage device.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Crawford (US Patent Number 5,771,354) in view of Schindler et al. (US Patent Number 5,675,390).

**Claims 1, 9, & 14:** Fig 3 shows a server device (52), a display device (54) and a game-executing device (68). Game-executing device (68) is the CPU of computer (52). A “set top box” is merely a computer that is associated with the cable television system. Fig 4 shows computer attached to the disclosed communications system via a cable TV connection (134). Computer (50(Z)) is a “set top box”. The server device has an information storage unit (64, 66) for storing game software. (Col 2, 15 & 16) The storage unit is a drive means or equivalent. Crawford discloses that game software may

Art Unit: 3714

be sent to a computer via communications lines (150) that are external to the server device, display device, and the game executing device and stored on the information storage unit. (Col 3, 37-39) Crawford fails to teach flash memory – thus there is no “storage means for storing game software”. There is inherently an information transmitting means (the computer’s bus) for reading software from the storage unit in response to a request received via digital communications line (the bus) and transmitting the information to the game-executing device. The game-executing device has game selection command input devices (56 & 58) and a game selection request transmission means (the bus) for transmitting the selection to the server. The keyboard (56) and mouse (58) are game control input means. The computer’s bus is an information request transmission means. The processor (68) is an information acquisition means and an image generation means and an image information acquisition means. There is a display device (54) for displaying images of the game. Figure 4 clearly shows that Customer Z is attached to the cable TV system. Furthermore, Crawford explicitly teaches that the data may be delivered via a satellite link. (Col 16, 64) Figure 2 teaches Electronic Media Services that include multi-media services. (206) This is equivalent to television program data. However, Crawford does not explicitly teach displaying television program data on the display device.

This is notoriously well known. Schindler teaches a system that receives satellite television signals on a set top box (118) and supplies television program data corresponding to the received television broadcast signal to a display device (122). (Fig 1) Schindler teaches that the system receives satellite television signals on a set top box

Art Unit: 3714

and supply television program data corresponding to the received television broadcast signal to a display device. (Col 1, 39-40) It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Crawford in view of

Schindler to receive satellite television signals on a set top box and supply television program data corresponding to the received television broadcast signal to a display device in order to significantly reduce the duplication of functions by discrete devices found in the home, thus reducing costs.

**Claims 2, 19, 23, & 24:** Crawford teaches the invention substantially as described.

Crawford teaches use of the multimedia content but does not teach details of its use nor does Crawford explicitly describe use of compressed image data. Schindler teaches provision of multimedia data using the MPEG compressed data format. (Col 2, 5-9 & Col 3, 6-10) As noted in Schindler, this has become the standard means for transmitting this data. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Crawford in view of Schindler to provide multimedia data in the industry standard MPEG compressed form since this has become the standard means for transmitting this data.

**Claims 3, 10, & 15:** Crawford teaches a server that contains an additional information acquisition means (68) that gets additional information via a communications link (150) and stores it to the storage unit (66, 64). There is an additional information transmission means (bus). The game-executing device (50) has an additional information selection command input means (56) and an additional information request transmission means (80).

Art Unit: 3714

**Claims 4, 11, 16 & 20:** Crawford teaches communication line connecting means (80) that is also an information request transmission means that transmits a request for desired information to the service provider via a communications line (150).

**Claims 5, 12, 17, 21 & 29:** Crawford teaches tracking, recording, storing, and updating usage history in order to perform accounting and billing. (Fig 8B, 414, 422, etc.)

Recitation of a function includes teaching the hardware necessary to carry out that function.

**Claims 6, 13, 18, 22 & 30:** Crawford teaches communication line connecting means (80) that is also a usage history information transmission means that transmits a request for desired information to the service provider via a communications line (150).

Transmission must be made in response to a usage history information transmission request or at a scheduled time.

**Claims 7 & 31:** Crawford's Fig 4 clearly teaches a digital serial bus.

**Claims 8 & 32:** Crawford's Fig 4 clearly teaches wireless communications channels.

**Claim 25:** Crawford's Fig 13 shows an additional data acquisition step (521). Input, transmission, storage, reading, and processing steps are included in this step.

**Claim 26:** Crawford's Fig 8A shows validating users (404A). Fig 13 clearly shows establishing communications, logging in, communication between game machine and server including request for information from the game software information provider.

**Claims 27 & 28:** Crawford's Fig 13 (515, 520) shows an authentication step. If the customer has an account, information is provided to the customer (521). This implies an information permission transmission and reception step. Fig 8B discloses a billing step.



*Response to Arguments*

11. Applicant submitted arguments in a request for reconsideration dated 14 June 2004. These were answered on 12 July 2004 in an Advisory Action. No further arguments were submitted with the RCE request.

*Conclusion*

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

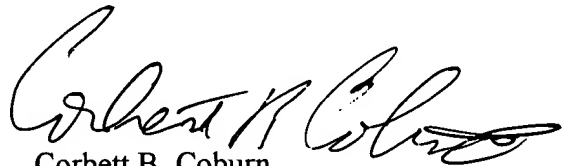
Reference Name	US Patent Number	Applicability
Davis et al.	6,594,677	Diskless workstation
Irwin et al.	5,404,527	Diskless workstation
Lidinsky et al.	4,897,874	Diskless workstation

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Corbett B. Coburn whose telephone number is (703) 305-3319. The examiner can normally be reached on 8-5:30, Monday-Friday, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on (703) 308-1745. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3714

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Corbett B. Coburn", is positioned above the printed name.

Corbett B. Coburn  
Examiner  
Art Unit 3714

cbc